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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,387

02/18/2004

J. Michael Rivera

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4345

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7590

09/23/2008

TOWNSEND AND TOWNSEND AND CREW, LLP

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EIGHTH FLOOR

SAN FRANCISCO, CA 94111-3834

EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

09/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/782,387

Applicant(s)

RIVERA ET AL.

Examiner

PRADEEP C. BATTULA

Art Unit

3725

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the reply filed on June 3, 2008

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu and Crum (U.S. PG Pub. 2005/0087977).

In regards to Claim 1, Kamen discloses a method of attaching a film to printed matter, comprising: printing a pattern on a substrate with UV curable ink (Column 1, Lines 50 – 55; Column 3, Lines 1 – 6); placing a film over said pattern (Column 1, Lines 57 – 61); and curing said UV curable ink with UV light (Column 1, Line 56; Column 3, Lines 1 – 6). Kamen teaches of attaching a film to the printed pattern without the need for an adhesive layer by use of an ink and wherein when foil is placed on the substrate it is peeled away and only the portions on the ink pattern remain (Column 1, Lines 59 – 61).

Kamen does not disclose the film is a holographic film and the UV curable ink is in an uncured state before the holographic film is placed over the ink and wherein said curing causes said holographic film to stick to said pattern.

Osamu discloses a method of attaching a hologram film to printed matter, comprising: printing a pattern on a substrate 3 with UV curable ink (Section 0005, Lines 1 – 10); placing a holographic film (5, 8) over said pattern (Section 0005, Lines 13 – 16); and curing said UV curable ink 4 with UV light (Section 0010, Lines 1 – 4; Generally known in art that UV ink is hardened by light; Section 0010, Lines 5 – 15; also cured with heat rollers – merely used to show that foil can be attached by curing of adhesive); wherein said curing causes said holographic film to stick to said pattern (Section 0010, Lines 5 – 15; Figure 1, Item 5; Figure 2, Items 2, 4, 8). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to substitute Osamu's film for Kamen's film in order to provide a more decorative coating to Kamen's substrate (Column 1, Lines 9 – 10, 45 – 47; Kamen).

Kamen modified by Osamu does not disclose the UV curable ink is in an uncured state before the holographic film is placed over the ink wherein said curing causes said holographic film to stick to said pattern.

Crum teaches of providing a non transparent top layer 10 (Paragraph 0033, Lines 1 – 8; Figure 1, Item 10; Figure 3, Item 210) which is provided on an uncured UV curable adhesive 220 (Paragraph 0033, Lines 1 - 2, 9 – 15 teaches of curing the adhesive through one or more layers therefore layers are applied before curing; Paragraph 0041, Lines 1 – 2) with the adhesive provided on a transparent or non

transparent bottom layer 230 (Paragraph 0037; Paragraph 0042, Lines 1 – 5; Figure 3, Items 210, 220, 230). The three layers are put together and then a bulb is used to cure the adhesive and which bonds the sheets together (Paragraph 0042, Lines 8 – 11 teaches of not being bonded and Paragraph 0044 – 0046 teach of the bulb and the curing stations that can be used with the entire structure being put together). Therefore it would have been obvious to a person having ordinary skill in the art to apply the methods of bonding a non transparent multilayer element having a UV curable coating, as taught by Crum, in order to provide a multilayer element of Kamen with the method of production which allows for element to be completed in its final configuration without any further method steps once curing is completed (Paragraph 0002, Lines 16 - 18).

In regards to Claim 19, as applied to Claim 14, Kamen modified by Osamu and Crum further discloses wherein said UV cured ink has low adhesion properties (Column 2, Lines 20 – 22, 42 - 52; Kamen; If ingredients are added to improve adhesion then adhesive strength is not initially high).

2. Claims 2 – 4, 15 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu, Crum and Howland et al. (Howland; U.S. 6,089,614).

In regards to Claims 2 – 4, as applied to Claim 1, Kamen modified by Osamu and Crum does not disclose wherein the UV curable ink has fluorescent, photo chromic, or thermo chromic properties.

Howland discloses a security device in which indicia that can be printed with UV curable ink (Column 7, Lines 19 – 21). Howland further discloses indicia as first and second indicia 7, 9 that can have thermo chromic, photo chromic, and fluorescent

properties (Column 8, Lines 12 – 18). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with various properties in order to further enhance the decorative properties of Kamen (areas in which there are no foil, ink edge surfaces can be seen in the gaps).

In regards to Claims 15 – 17, as applied to Claim 14, please refer to the rejection for Claims 2 – 4.

3. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu, Crum and Roth.

In regards to Claim 5, as applied to Claim 1, Kamen modified by Osamu and Crum does not disclose the UV curable ink has bi-chromic properties.

Roth discloses that it is well known in the art to have a UV curable ink that changes color, therefore having bi-chromic properties (Column 2, Lines 33 – 38). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with various properties in order to further enhance the decorative properties of Kamen (areas in which there are no foil, ink edge surfaces can be seen in the gaps).

In regards to Claim 18, as applied to Claim 14, please refer to the rejection for Claim 5.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu, Crum and Scarbrough et al. (Scarbrough; U.S. Pub 2004/0140665).

In regards to Claim 6, as applied to Claim 1, Kamen modified by Osamu and Crum does not disclose wherein the UV curable ink is scratch-off ink.

Scarborough discloses an image with an illusion of three dimensions using opaque ink which is UV curable (Paragraph 0064, Lines 12 – 20). It is known to one with ordinary skill in the art that many opaque inks are scratch off. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the UV curable ink of Kamen with scratch off properties in order to allow easy removal of any unwanted decoration.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

With respect to the use of Osamu's foil, the method of production is that that which is preferred by Osamu in that particular embodiment. Osamu is only used to teach of providing a foil to a substrate and the combination is a mere substitution of one foil for another.

Crum has now been presented to teach of providing the layers together and then curing where in Crum this adheres are layers to one another.

The ink of Kamen teaches of adhesive capability and providing the layers together and then curing would at least make a partial bond with the already attached foil layer. With respect to the combination with Crum, the foil can be attached before curing since the method of securing with the heat is only used to attach to the glass. Kamen clearly states that the foil does adhere to the ink (Column 1, Lines 59 – 61) and therefore curing the ink in a method process as taught by Crum will still cause the curing to stick the holographic foil to the ink layer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
September 18, 2008

/DANA ROSS/
Supervisory Patent Examiner, Art Unit 3725